

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Leonard Robert Speiser et al.	Examiner:	Asfand Sheikh
Serial No.:	10/666,681	Group Art Unit:	3627
Filed:	September 18, 2003	Docket:	2043.093US1
Title:	PRODUCT RECOMMENDATION IN A NETWORK-BASED COMMERCE SYSTEM		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants request review of the final rejections in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below:

§ 102 Rejections of the Claims

Claims 15-22 were rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Spiegel et al. (U.S. Patent No. 6,466,918, hereinafter “Spiegel”). To anticipate a claim, a reference must teach **each and every element** of the claim,¹ as arranged in the claim,² and in as complete detail as in the claim.³ Applicants respectfully submit that the cited reference does not establish a *prima facie* case of anticipation, because the cited reference fails to teach each and every claimed element of Applicants’ subject matter, as arranged in the claims, and in as complete detail as in the claims.⁴

¹ “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

² It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, **arranged as in the claim.**” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983), emphasis added.

³ “The identical invention must be shown **in as complete detail** as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131; emphasis added.

⁴ “[T]he exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983).

Independent claim 15 recites, in part, “**identifying** at least one **frequently used search term** associated with the identified division.”⁵ In the Final Office Action dated July 15, 2009, the Examiner cited FIG. 1A of Spiegel and “col. 4, lines 43-67; col. 6, lines 5-60; col. 7, lines 6-67; [and] col. 8, lines 33-59 ” of Spiegel as allegedly disclosing this element.⁶ The entirety of Spiegel, however, actually fails to disclose **identifying a frequently used search term**, as recited in claim 15.

In the Final Office Action, the Examiner asserted that “the frequently-used search term “Olympics” [is] associated with the second identified division under “Featured Categories” in Figure [1A].”⁷ FIG. 1A of Spiegel actually depicts the phrase “Olympics (75 Bestsellers)” as one of three “Featured Categories” on a web page.⁸ The cited text of Spiegel explicitly states that “FIG. 1A illustrates an example Web page that includes . . . **featured book categories** 110 and featured book titles 120.”⁹ Spiegel explicitly explains that “the featured book categories and featured book titles are derived from the Sports & Outdoors branch of the browse tree.”¹⁰ In fact, Spiegel specifically refers to “Olympics” as a “**category**.”¹¹ Therefore, according to unambiguous language in Spiegel, the word “Olympics” shown in FIG. 1A of Spiegel is a title of a **category** that was derived from a branch of a browse tree.

A title of a **category** is not functionally equivalent to a **search term**. Spiegel expressly states that “[m]any online merchants and other businesses group their products, services or other items into a set of categories and subcategories of a browse tree.”¹² To those of ordinary skill in the art, a **category** that groups products, services, or other items does not have the same functionality as a **search term**. Accordingly, **deriving a category** from branch of a browse tree is not functionally equivalent to **identifying a search term**, much less identifying a **frequently used search term**.

⁵ Claim 15, emphasis added.

⁶ Final Office Action, page 4.

⁷ *Id.* at page 2.

⁸ Spiegel, FIG. 1A, item 110.

⁹ *Id.* at column 7, lines 6-8, emphasis added.

¹⁰ *Id.* at column 7, lines 8-11, internal quotations and references omitted, emphasis added.

¹¹ *Id.* at column 7, lines 12-13, “**the category “Olympics”** is featured . . . ,” emphasis added.

Although column 6, lines 16-24 of Spiegel discusses that “[n]ode popularity levels are . . . determined based on user activity data . . . [that] may include . . . the **number** of searches performed **within** each category,”¹³ a mere number is not functionally equivalent to a **search term**. Indeed, the phrase “**search term**” does not appear at all in Spiegel, and Spiegel makes no mention of any functional equivalent thereof.

In the Advisory Action dated October 7, 2009, the Examiner cited column 6, lines 40-60 of Spiegel as allegedly disclosing that “a category can be searched by a user.”¹⁴ Within column 6 of Spiegel, the only mention of “search” appears in lines 21-24, which are discussed above, and Applicants respectfully suggest that the Examiner’s citation is in error. As noted above, mere mention of a **number** of searches fails to disclose **identification of a frequently used search term**, or any functional equivalent thereof. Moreover, mere discussion of searches performed **within** a category does not support any reasonable inference that a category is somehow functionally equivalent to a **frequently used search term**.

In the Advisory Action, the Examiner also pointed to column 6, lines 21-29 of Spiegel as allegedly disclosing that “category data nodes includes [sic] data related to activity with the category.”¹⁵ Spiegel, however, does not use the phrase “data node” or “category data node” anywhere, and Applicants respectfully request that the Examiner clarify the rationale for this citation. As noted above, column 6, lines 16-24 of Spiegel discuss that “[n]ode popularity levels are . . . determined based on **user activity data**”¹⁶ Mere discussion of determining a popularity level based on user activity data does not disclose identification of a **frequently used search term**, or any functional equivalent thereof.

¹² *Id.* at column 1, lines 25-27.

¹³ *Id.* at column 6, lines 16-24, emphasis added.

¹⁴ Advisory Action, page 2, lines 4-5, internal quotations omitted.

¹⁵ *Id.* at page 2, line 6.

¹⁶ Spiegel, column 6, lines 16-17, emphasis added.

Moreover, Spiegel contains no discussion whatsoever of **frequency of use** with respect to a **search term**. As a result, nothing in Spiegel discloses **identifying a frequently used search term**, much less identifying a frequently used search term that is associated with an identified division, as recited in claim 15. Thus, Spiegel fails to disclose at least this element.

Furthermore, independent claim 15 recites, in part, “providing a **link** to the user **to listings associated with the** at least one frequently used **search term**.”¹⁷ In the Final Office Action, the Examiner cited “Figure 1” of Spiegel and “column 4, lines 61-67” of Spiegel as allegedly disclosing this element.¹⁸ The entirety of Spiegel, however, actually fails to disclose providing a link to listings associated with a search term, as recited in claim 15.

In the Final Office Action the Examiner asserted that “the items/listings shown in Figure [1A] are hyperlinks.”¹⁹ As noted above, “FIG. 1A [of Spiegel] illustrates an example Web page that includes . . . featured book **categories** 110 and featured **book** titles 120.”²⁰ Moreover, “[t]he featured **books** and **categories** are displayed as respective hyperlinks that provide a direct path to the corresponding **books** and **categories**.”²¹ Furthermore, the cited text of Spiegel states that “[e]ach node [of the browse tree] is . . . displayed . . . as a hyperlink (see FIG. 1A),”²² and “[s]election of a node (hyperlink) causes the children of the node to be displayed.”²³ Therefore, according to Spiegel, each hyperlink shown in FIG. 1A of Spiegel is simply a **link to a corresponding book or category** in the browse tree, none of which are described in Spiegel as being associated with a **search term**, much less a **frequently used** search term. Spiegel is entirely silent with respect to a frequently used search term, as recited in claim 15. As a result, Spiegel fails to disclose providing a **link to listings associated with a frequently used search term**, or any functional equivalent thereof. Thus, Spiegel does not disclose at least this element.

¹⁷ Claim 15, emphasis added.

¹⁸ Final Office Action, page 3.

¹⁹ *Id.*

²⁰ Spiegel, column 7, lines 6-8.

²¹ *Id.* at column 7, lines 17-19.

²² *Id.* at column 4, lines 61-62.

²³ *Id.* at column 4, lines 64-65.

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Because **each and every element** of independent claim 15 is not set forth in the cited reference, as arranged in the claim, and in as complete detail as in the claim, no *prima facie* case of anticipation is established. For at least these reasons, independent claim 15 and its dependent claims are patentable over the cited reference. Moreover, the dependent claims may each be patentable based on elements recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

CONCLUSION

Applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at (408) 278-4048 to discuss any questions which may remain with respect to the present application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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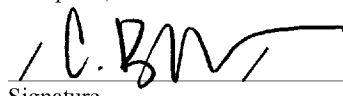
By 1


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14th day of October, 2009.

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